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09/847,505	05/02/2001	John C. Voudouris	72270-9004-01	8515
23409	7590	10/25/2005		
MICHAEL BEST & FRIEDRICH, LLP 100 E WISCONSIN AVENUE MILWAUKEE, WI 53202			EXAMINER LEWIS, RALPH A	
			ART UNIT	PAPER NUMBER
			3732	
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/847,505  
Filing Date: May 02, 2001  
Appellant(s): VOUDOURIS, JOHN C.

**MAILED**

**OCT 25 2005**

**Group 3700**

Kevin Moran  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 01 August 2005 appealing from the  
Office action mailed 22 February 2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

### **NEW GROUND(S) OF REJECTION**

The obvious-type double patenting rejection based on applicant's earlier patents 6,257,883; 5,913,680; and 5,474,445 has been changed to include Rosenberg (US 4,634,662) as a secondary reference.

### **WITHDRAWN REJECTIONS**

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner.

Applicant's remarks with respect to the "mesio-distal axis" have been found persuasive and the 35 U.S.C. 102(b) rejection based on Rosenberg with respect to claims 48-53 is withdrawn. Additionally, the objection to the specification for failing to provide proper antecedent basis for the "mesio-distal axis" is withdrawn in view of applicant's remarks.

### **(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

### **(8) Evidence Relied Upon**

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

4,634,662	Rosenberg	01-1987
5,474,445	Voudouris	12-1995
5,913,680	Vourdouris	6-1999
6257883	Voudouris	07-2001

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

#### **Rejections based on 35 U.S.C. 112, second paragraph**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 52 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 52, line 2, it is unclear how the shutter "end" relates to that already set forth in the parent claim 48. Dependent claims must reasonably relate back to the claims from which they depend.

The examiner is in agreement that appellant's proposed After-Final amendment with regard to claim 52 overcomes the indefiniteness issue and is willing to permit its entry provided the application is otherwise in condition for allowance.

### Obvious-type Double Patenting Rejections

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 41-57 and 59 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over

claims 1-13 of U.S. Patent No. 6,257,883;

claims 1-22 of U.S. Patent No. 5,913,680; and

claims 1-15 of U.S. Patent No. 5,474,445

each in view of Rosenberg (US 4,634,662).

Although the conflicting claims are not identical, they are not patentably distinct from each other because one of ordinary skill in the art would have found it obvious to have presented the earlier claimed orthodontic bracket in the terms of the present claims, particularly in view of the teaching by Rosenberg.

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More particularly with respect to 6,257,883, patented claim 1 of '883 sets forth a body meeting the limitations of the presently claimed body, patented claims 2-4 of '883 set forth at least two tie wings which one of ordinary skill in the art would understand to have a space there between and patented claim 1 of '883 sets forth currently claimed locking shutter. Patented claim of '883 calls for "at least one tie wing" to which one end of the "locking shutter is pivotally attached." As argued by appellant the patented claims of '883 do not explicitly require that a stem of the locking shutter be positioned in the space between the tie wings. Patented claim 1 of '883 fails to specifically state where or how the end of the locking shutter is attached to the "at least one tie wing."

Rosenberg, however, for a similar orthodontic bracket in Figure 5 having conventional spaced apart tie wings 2 and a locking shutter 1 teaches that it is desirable to position the pivot and stem of the shutter 5 in the space between the tie wings. To have merely positioned the stem and pivot of the '883 patented locking shutter in the space between the tie wings as is taught by Rosenberg to be a convenient and desirable space to position the stem and pivot would have been obvious to one of ordinary skill in the art in view of the Rosenberg teaching. In regard to the "body and the tie wings collectively forming a labial surface having a notch formed therein" limitation of the present claims, the examiner is of the firm position that brackets having plural tie wings inherently possess structure which meet the broad "notch" limitation.

In response to the present rejection appellant points to patented claim 7 of '883 and asserts that '883 is directed to a different embodiment than that currently claimed.

Perhaps patented claim 7 is, but certainly patented claim 1 is not. The present claims are merely an obvious variation of those already patented.

More particularly in regard to applicant's earlier patent 5,913,680, patented claim 1 of '680 sets forth a body that defines an arch wire slot, at least two spaced apart tie wings and a locking shutter. As argued by appellant the patented claims of '680 do not explicitly require that a stem of the locking shutter be positioned in the space between the tie wings. Rosenberg, however, for a similar orthodontic bracket in Figure 5 having conventional spaced apart tie wings 2 and a locking shutter 1 teaches that it is desirable to position the pivot and stem of the shutter 5 in the space between the tie wings. To have merely positioned the stem and pivot of the '680 patented locking shutter in the space between the tie wings as is taught by Rosenberg to be a convenient and desirable space to position the stem and pivot would have been obvious to one of ordinary skill in the art in view of the Rosenberg teaching. In regard to the "body and the tie wings collectively forming a labial surface having a notch formed therein" limitation of the present claims, the examiner is of the firm position that brackets having plural tie wings inherently possess structure which meet the broad "notch" limitation. Additionally it is noted that patented claim 1 of '680 includes the additional limitation of a "biasing means," merely eliminating elements from a patented claim in order to make it broader is a simple matter of claim construction and most certainly would have been obvious to the ordinarily skilled artisan.



Finally, with respect to 5,474,445, patented claim 1 of '445 sets forth a bracket having a body, an archwire slot, a plurality of tie wings which the ordinarily skilled artisan would readily recognize as being spaced apart (if not spaced apart then there would be just one big tie wing) and a pivotal latch which (i.e. "shutter") movable between open and closed positions which provide access to the archwire slot. As argued by appellant the patented claims of '445 do not explicitly require that a stem of the locking shutter be positioned in the space between the tie wings. Rosenberg, however, for a similar orthodontic bracket in Figure 5 having conventional spaced apart tie wings 2 and a locking shutter 1 teaches that it is desirable to position the pivot and stem of the shutter 5 in the space between the tie wings. To have merely positioned the stem and pivot of the '445 patented locking shutter in the space between the tie wings as is taught by Rosenberg to be a convenient and desirable space to position the stem and pivot would have been obvious to one of ordinary skill in the art in view of the Rosenberg teaching. In regard to the "body and the tie wings collectively forming a labial surface having a notch formed therein" limitation of the present claims, the examiner is of the firm position that brackets having plural tie wings inherently possess structure which meet the broad "notch" limitation. Additionally it is noted that patented claim 1 of '445 includes additional detailed limitations not present in the currently pending claims, merely eliminating elements from a patented claim in order to make it broader is a simple matter of claim construction and most certainly would have been obvious to the ordinarily skilled artisan.

### Rejections based on Prior Art

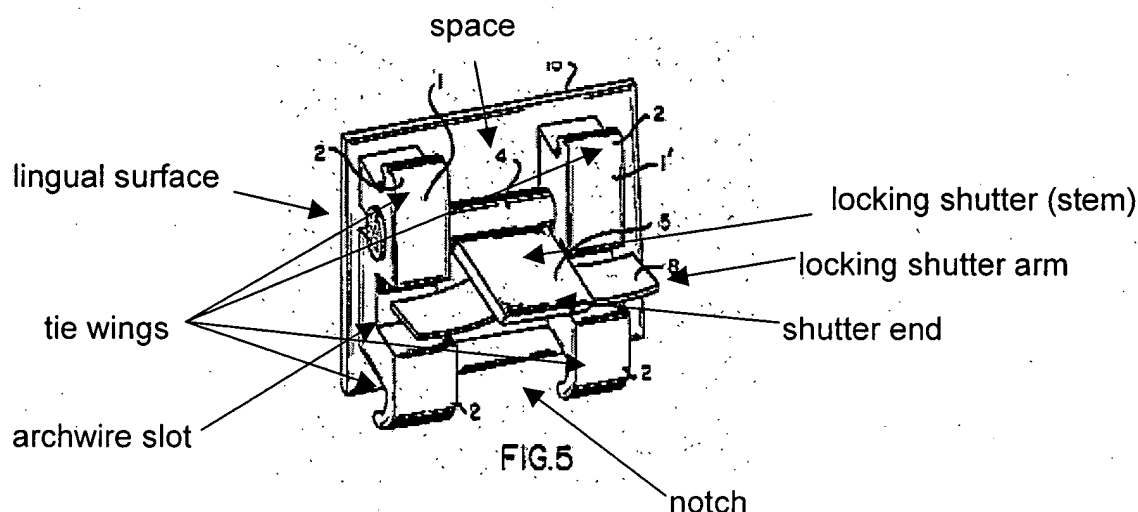
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 41-47, 54-57 and 59 are rejected under 35 U.S.C. 102(b) as being anticipated by Rosenberg (US 4,634,662).

Note Figure 5 of Rosenberg reproduced below with identified elements meeting the claim limitations.



In response to the present rejection, appellant argues that "Rosenberg does not teach, suggest or disclose a body and tie wings collectively forming a labial surface having a notch formed therein." The examiner directs attention to the above illustration and the word "notch" and its accompanying arrow pointing to a "notch" in the Figure 5.

Appellant argues that the "notch" identified by the examiner is not a "notch" but a "space". The examiner is of the position that by definition a "notch" is a "space" formed between two walls, that a "space" may be empty or "space" or may be "space" occupied by matter, that "space" may be infinitely "small" or infinitely large and that a "notch" may occupy "space." Appellant is simply reading much more into the common terms than is reasonable. It has been suggested repeatedly throughout the prosecution of the application that if applicant desires the term "notch" to have some narrower definition then applicant should clearly amend the claims so as to appraise the examiner and the public of his intended definition. The examiner is required to give common terms such as "notch" their broadest reasonable interpretation.

Appellant further argues with respect to claim 41 that "no notch is formed in the labial surface of the Rosenberg tie wings 2." Perhaps, but that is not what is claimed. What is claimed is that "the body and the tie wings collectively forming a labial surface having a notch formed therein." The examiner is of the firm position that the "notch" identified above in the reproduced Figure 5 of Rosenberg meets the language of the claim.

With respect to claims 54-57 and 59, appellant references the Figure 2 embodiment of Rosenberg. The rejection is based on the Figure 5 embodiment of Rosenberg, not the Figure 2 embodiment. As illustrated above in the examiner's reproduction of Rosenberg Figure 5, the Rosenberg Figure 5 embodiment includes a

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"notch" as labeled which extends into the archwire slot and which receives the end of the shutter 5 when in the closed position.

**(10) Response to Argument**

Appellant's arguments have been addressed in the rejections above.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

**(1) Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

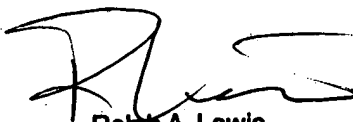
**(2) Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR

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41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).


Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

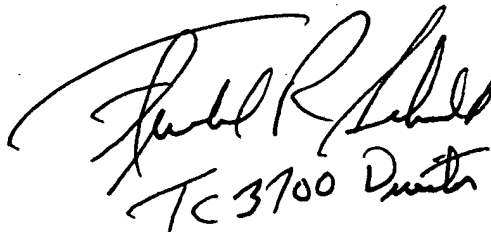
Respectfully submitted,

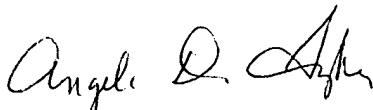
  
Ralph A. Lewis  
Primary Examiner  
Au 3732

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

Conferees:

  
KEVIN SHAVER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700

  
TC 3700 Director



ANGELA D. SYKES  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700